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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/214,971 01/15/99 VALENTE

G 30966.13USWO

EXAMINER

IM62/0614

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ART UNIT

PAPER NUMBER

1772

DATE MAILED:

06/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/214,971

Applicant(s)

Valente

Examiner

Allcia Chevalier

Group Art Unit

1772



☒ Responsive to communication(s) filed on Apr 4, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 5-23 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 5-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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RESPONSE TO AMENDMENT

NEW REJECTIONS

1. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Double Patenting

2. Applicant is advised that should claim 6 be found allowable, claims 11 and 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). These claims are word for word duplicates of each other.
3. Applicant is advised that should claim 7 be found allowable, claims 12 and 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). These claims are word for word duplicates of each other.

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4. Applicant is advised that should claim 8 be found allowable, claims 14 and 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). These claims are word for word duplicates of each other.

Claim Rejections - 35 USC § 112

5. Claims 5-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a mixture of leather regenerated materials or derivatives thereof" in claims 5, 10, 15, and 22 is unclear and renders the claims vague and indefinite. It is uncertain what "regenerated materials" means and there is no definition in the specification to allow one of ordinary skill in the art to know what materials are desired by applicant.

The phrase "coagulated material" in claims 5, 10, 15, and 22 is unclear and renders the claims vague and indefinite. It is uncertain what types of coagulated materials applicant wishes to claim. The term "coagulated" is very board and encompasses almost any material.

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The phrase “perspiring material” in claims 5, 10, 15, and 22 is unclear and renders the claims vague and indefinite. It is uncertain what type of perspiring materials applicant wishes to claim. The term “perspiring” is very broad and encompasses almost any material.

The term “leather-like” in claims 6, 11, and 16 is unclear and renders the claims vague and indefinite. The claim is indefinite because it does not clearly state to what degree the composite material should smell of leather. The use of the word **like**, in particular, is unclear.

The phrase “film in polyethylene” in claim 15 is unclear and renders the claim vague and indefinite. It is assumed the film is not made of polyethylene not encapsulated by polyethylene.

Claims 20 and 21 are unclear and render the claims vague and indefinite. Both claims further limit the claims they are dependent on by “including an embossed surface of film.” Is the “embossed surface of film” another layer or just the covering surface layer. For purposes of examination it is taken to be the covering surface layer.

Claim 23 recites the limitation “wherein embossing is effected simultaneously with coupling the film to the support material,” which is unclear and renders the claim vague and indefinite. Is claim 23 claiming that the embossing is done at the same time the two layers are coupled together.

6. Claims 8-9, 13-14, and 18-19 provides for the use of “a composite material”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely

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recites a use without any active, positive steps delimiting how this use is actually practiced. The following is from the MPEP §2173.05(q) "Use Claims":

Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon" was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1086).

Claims 8-9, 13-14, and 18-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 8-9, 13-14, and 18-19 claim, "A use of a composite material." "A use" is not a statutory class of subject matter under 35 U.S.C. 101. It is unclear from the claim language whether the use of the composite material is with regard to the method or product.

7. For the purpose of the following rejections under 35 U.S.C. 102 and 35 U.S.C. 103 little weight is given to process limitations. Determination of patentability of product-by-process claims is based on the product itself and does not depend on the product's method of production.

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Claim Rejections - 35 USC § 102

8. Claims 5, 7, 12, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by GB1514224. For reasons of record in paper #3, page 5, paragraph 4.
9. Claims 5, 10, 15, 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by GB1466030A. GB1466030A teaches a resin coated paper comprising a paper (cellulosic material) support and a polyethylene layer (page 2, lines 12-14, figures 2-4). A patterned is applied to the resin coated paper via an embossing calender (page 1, lines 52-54, figure 1).

Claim Rejections - 35 USC § 103

10. Claims 5-7, 11, 12, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB1514224 in view of Hara (JP404130172A). For reasons of record in paper #3, page 6, paragraph 6.

ANSWERS TO APPLICANT'S ARGUMENTS

11. Applicant's arguments filed in paper #4 regarding the advance over the prior art has been considered but are deemed unpersuasive.

All the independent claims are basically claiming a substrate composed of almost any material covered with an embossed polyethylene film, which is well known in the art. As for applicant's assertion that the "invention is directed to providing a high surface resistance which

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is non-toxic and is thus usable for contacting a person's skin for a relatively long time" there are no limitations in the claims stating this limitation or limitations on how the composite material would arrive at having these characteristics. Also, the fact that the composite material has the embossing and coupling of the film to the support material effected simultaneously is given little patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Determination of patentability of product-by-process claims is based on the product itself and does not depend on the product's method of production.

12. Applicant's arguments filed in paper #4 regarding the GB1514224A reference has been considered but are deemed unpersuasive.

As stated above, the fact that the composite material has the embossing and coupling of the film to the support material effected simultaneously is given little patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Determination of patentability of product-by-process claims is based on the product itself and does not depend on the product's method of production. Also, the fact that GB1514224A reference includes additional structure not required by Applicant's invention, it must be noted that the GB1514224A reference discloses the invention as claimed, except claim 22. The fact that it discloses additional structure not claimed is irrelevant.

13. Applicant's arguments filed in paper #4 regarding the term "regenerated leather" has been considered but are deemed unpersuasive.

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The rejection is to the whole phrase "a mixture of leather regenerated materials or derivatives thereof." The term "regenerated leather" may be a commonly used term in the leather working industry, but what is the mixture and the derivatives and is it regenerated leather or regenerated materials. If it is regenerated materials, what constitutes a regenerated material.

14. Applicant's arguments filed in paper #4 regarding what the invention is directed to has been considered but are deemed unpersuasive.

Applicant states that the invention "is directed to providing a product to provide a leather-type effect which goes beyond normal working technique of leather." Further stated is that it "is not a normal technique because it would not be a natural consideration to cover leather with polyethylene." This may or may not be true, but since applicant is claim a variety of substrates, not just leather, to be covered with an embossed polyethylene layer it has been found to be well known to add an embossed polyethylene film to a substrate.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

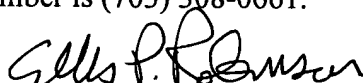
If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac



June 12, 2000



Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700